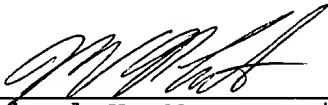


- ☐ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - \$0.00.
- ☒ Fee for filing an Appeal Brief - \$330.00 (large entity).
- ☒ Check(s) in the amount of \$330.00 is(are) attached.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #39,491  
for Michael K. Mutter, #29,680

  
MKM/CMV/jdm  
0879-0242P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment(s)

(Rev. 02/08/2004)



PATENT  
0879-0242P

**IN THE U.S. PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Takeshi MISAWA

Appeal No.:

APPL. NO.: 09/432,087

GROUP: 2835

FILED: November 2, 1999

EXAMINER: VORTMAN, A.

FOR: ARRANGEMENT OF CARD SLOT IN LAPTOP  
COMPUTER

**APPEAL BRIEF**



0879-0242P

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Takeshi MISAWA

Appeal No.:

APPL. NO.: 09/432,087

GROUP: 2835

FILED: November 2, 1999

EXAMINER: VORTMAN, A.

FOR: ARRANGEMENT OF CARD SLOT IN LAPTOP  
COMPUTER

### **TABLE OF CONTENTS**

I.	REAL PARTY IN INTEREST .....	1
II.	RELATED APPEALS AND INTERFERENCES.....	1
III.	STATUS OF CLAIMS .....	2
IV.	STATUS OF AMENDMENTS .....	2
V.	SUMMARY OF THE INVENTION.....	2
VI.	THE GROUNDS OF REJECTION .....	4
VII.	ISSUES ON APPEAL.....	5
VIII.	GROUPING OF CLAIMS .....	5
IX.	ARGUMENT.....	5
A.	Issue (1): The <i>Ma</i> Rejection .....	5
1.	Argument Summary.....	5
2.	The Legal Requirements of <i>Prima Facie</i> Anticipation .....	6
3.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 1 .....	6
a.	Functional Recitations Should Be Afforded Patentable Weight Even If In Narrative Form .....	8
b.	“a chamber capable of accepting a removable external device” Should Be Afforded Patentable Weight.....	9
4.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claims 2-7, 9, 11, and 24-25 .....	13
5.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 13 .....	14

6.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 14 .....	15
7.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 15 .....	16
8.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 16 .....	17
B.	Issue (2): The <i>Brenner</i> Rejection .....	18
1.	Argument Summary .....	18
2.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 17 .....	19
3.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 29 .....	20
4.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 30 .....	21
C.	Issue (3): The <i>Griencewic</i> Rejection .....	22
1.	Argument Summary .....	22
2.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 31 .....	23
D.	Issue (4): The <i>Ma/ Smith</i> Rejection .....	24
1.	Argument Summary .....	24
2.	The Legal Requirements of <i>Prima Facie</i> Obviousness .....	24
3.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 12 and 28 .....	25
E.	Issue (5): The <i>Ma/ Brenner</i> Rejection .....	26
1.	Argument Summary .....	26
2.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claims 10 and 26 .....	26
X.	CONCLUSION .....	28
	Appendix of Claims .....	A-1

IN RE APPLICATION OF	BEFORE THE BOARD OF APPEALS
Takeshi MISAWA	Appeal No.:
APPL. NO.: 09/432,087	GROUP: 2835
FILED: November 2, 1999	EXAMINER: VORTMAN, A.
FOR: ARRANGEMENT OF CARD SLOT IN LAPTOP COMPUTER	

**APPEAL BRIEF ON BEHALF  
OF APPELLANT:  
TAKESHI MISAWA**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

May 10, 2004

Sir:

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, FUJI PHOTO FILM CO., LTD., No. 210 Nakanuma, Kanagawa, Minami-Ashigara-shi JAPAN.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pending with respect to the subject matter of the present application.

### III. STATUS OF CLAIMS

Claims 1-17 and 24-31 remain pending. Claims 1, 13-17, and 31 are independent. No claims have been allowed. Claim 8 has been objected to as being dependent upon a rejected base claim, but the Examiner indicated claim 8 would be allowable if rewritten in independent form to include all of the elements of the independent claim and any intervening claims.

### IV. STATUS OF AMENDMENTS

No amendments have been presented after the Final Rejection.

### V. SUMMARY OF THE INVENTION

The invention of the subject application is a personal computer that provides for a display unit being operatively interconnected to a base unit. The personal computer further provides for a chamber being arranged in a display unit wherein the chamber may accept a removable external device enhancing a function of the personal computer (Specification, page 2, lines 17-24).

An embodiment of the present invention includes flat display 18 such as a liquid crystal display (LCD) incorporated in the display unit 14. When the laptop computer 10 is in use, the display unit 14 is opened so that the face of the flat display 18 forms a desirable angle, which may be an obtuse angle or a right angle, with the operation face of the keyboard 16. When the laptop computer 10 is not in use, the display unit 14 is closed over the operation face of the keyboard 16 with the face of the display 18 being inward (see Fig. 2). In Fig. 2, the top face of the base unit 12 is entirely closed with the display unit

14. However, a part of the top face of the base unit 12 may remain exposed when the display unit 14 is closed (Specification, page 5, lines 6-14).

The display unit 14 has a chamber or PC card slot 20, which may open at a top (in the opened state) side of the display unit 14. A PC card or a variety of external devices enhancing functions of the laptop computer 10 can be accepted in the PC card slot 20 (Specification, page 5, lines 15-20).

Fig. 3 shows an example wherein a radio wave communication card 24 is mounted in the laptop computer 10 in Fig. 1. The radio wave communication card 24 is inserted in the PC card slot 20 so that an antenna part 25 can be arranged almost vertically at a higher position than the display 18. The laptop computer 10 of this embodiment has the PV card slot 20 at the display unit 14, and therefore, the radio wave communication card 24 can be located at a suitable position for the transmission and reception of radio waves (Specification, page 5, line 21 through page 6, line 1).

Fig. 4 shows an example wherein a PC card camera 30 is mounted in the laptop computer 10 in Fig. 1. By inserting the PC card camera 30 into the PC card slot 20, an image pickup part 31 is arranged at a higher position than the display 18. Therefore, it is each to capture an image of a person who is operating the laptop computer 10, and the laptop computer 10 is applicable to a TV conference system, or the like (Specification, page 6, lines 7-15).

Alternatively, the PC card slot may be arranged at the right or left side of the display in order to prevent the PC card slot and the display 18 from overlapping (Specification, page 6, lines 20-25).



The description of the invention herein has been made to comply with the Patent Office rules regarding submitting briefs and is not to be considered as limiting the claimed invention.

VI. THE GROUNDS OF REJECTION

The Examiner has rejected all pending claims as follows:

- (1) Claims 1-7, 9, 11, 13-16, 24-25, and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Ma* (USP 5,880,928) (hereinafter "*Ma*");
- (2) Claims 17, 29, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Brenner et al.* (USP 5,786,987) (hereinafter "*Brenner*");
- (3) Claim 31 stands rejected under 35 U.S.C. § 102(b) as being anticipated by *Griencewic* (USP 5,801,919) (hereinafter "*Griencewic*");
- (4) Claims 12 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ma* in view of *Smith, II* (USP 5,768,163) (hereinafter "*Smith*"); and
- (5) Claims 10 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ma* in view of *Brenner*.

VII. ISSUES ON APPEAL

The issue to be resolved in this application is:

- (1) Whether claims 1-7, 9, 11, 13-16, 24-25, and 27 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by *Ma* (USP 5,880,928) (hereinafter “*Ma*”);
- (2) Whether claims 17, 29, and 30 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by *Brenner et al.* (USP 5,786,987) (hereinafter “*Brenner*”);
- (3) Whether claim 31 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by *Griencewic* (USP 5,801,919) (hereinafter “*Griencewic*”);
- (4) Whether claims 12 and 28 are unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Ma* in view of *Smith, II* (USP 5,768,163) (hereinafter “*Smith*”); and
- (5) Whether Claims 10 and 26 are unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Ma* in view of *Brenner*.

VIII. GROUPING OF CLAIMS

All claims stand or fall separately.

IX. ARGUMENT

A. Issue (1): The *Ma* Rejection

1. Argument Summary

The Examiner’s rejection of claims 1-7, 9, 11, 13-16, 24-25, and 27 under 35 U.S.C. § 102(e) as being anticipated by *Ma* fails to establish *prima*

*facie* anticipation. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the *Ma* reference that a detailed reading of the reference reveals are not taught therein.

2. The Legal Requirements of *Prima Facie* Anticipation

In order to properly anticipate Appellants' claimed invention under 35 U.S.C. §102 each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131 (8th Ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131 (8th ed. 2001), p. 2100-69.

3. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 1

Independent claim 1 is directed to a personal computer including, *inter alia*, a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit.

In maintaining his rejection of independent claim 1, the Examiner asserts in the Official Action mailed December 11, 2003, page 3, lines 4-5, *Ma* teaches:

... a chamber for accepting a removable external device (222 or 212) enhancing a function of the personal computer ...

Appellant respectfully disagrees that *Ma* discloses “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit” as set forth in independent claim 1.

The Examiner relies upon CCD camera 222 and sound boxes 212 to teach or suggest a removable external device.

The disclosure of *Ma* at col. 1, line 62 through col. 2, line 6 is as follows:

The present invention differs from the prior art in that a sound hole 21 is formed at either side of the display 2. Each sound hole 21 has a sound box connecting device 211 in the form of a pivot rod for connection with a sound box 212, and an amplifying speaker disposed inside. At the same time, at a top rim of an upper side after the display 2 is lifted, i.e., in the direction opposite to the rotary shaft, there is also provided a camera hole 22 which is connected via a camera connecting device 221 to a CCD camera 222. The above-mentioned sound box 212 and CCD camera 222 respectively have circuits passing through the rotary shaft to be connected to the mainframe.

As evidenced from the above citation, together with Figs. 3 and 4, *Ma* teaches CCD camera 222 and sound box 212 including wires that indicate a permanent connection to the computing device.

In response to Appellant’s arguments, in the Official Action mailed July 17, 2003, the Examiner responds by asserting wires do not preclude the device from being removed from a main unit, firstly because even if connected by wires, the device may still be considered as being removed, and secondly because the wires may be disconnected. Appellant submits that the Examiner’s interpretation of the word “removable” as set forth in the claim is overly broad.

It is respectfully submitted that if the CCD camera 222 is connected to the notebook computer, then the camera would not be considered to be removed from the chamber. Second, if the CCD camera were disconnected as suggested by the Examiner, in order to do this, the notebook computer would need to be disassembled in order to properly disconnect the CCD camera. If the notebook was not disassembled, the CCD camera would be damaged upon removal. Additionally, in order to reconnect the CCD camera, disassembly of the notebook computer would again need to take place. As such, it is respectfully submitted that the CCD camera as cited by the Examiner is not "removable". It is respectfully submitted that *Ma* fails to anticipate the invention as set forth in claim 1. For at least these reasons, based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102.

a. Functional Recitations Should Be Afforded Patentable Weight Even If In Narrative Form

The Examiner additionally asserts in support of his rejection that the functional recitations are not to be given patentable weight because they are in narrative form. It is respectfully submitted that claims, by their nature are in narrative form. Under 37 C.F.R. § 1.75, claims must particularly point out and distinctly claim the subject matter, which the applicant regards as his invention or discovery. The MPEP, in Section 608.01(m), requires that each claim be the object of a sentence starting with "I (or we) claim," or some

equivalent. Further, this section requires that each claim begin with a capital letter and end with a period. Finally, the section requires that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There is no qualification either in the rules or the statutes that functional language in narrative form is not afforded patentable weight. In fact, as noted above, courts have explicitly stated that functional weight is afforded to functional language in the claims.

b. "a chamber capable of accepting a removable external device" Should be Afforded Patentable Weight

The Examiner additionally asserts in the Official Action mailed December 11, 2003, on page 3, lines 8-14 as follows:

Regarding the functional recitation that the chamber is *capable or adapted of interchangeably accepting a removable external device*, please note that the aforementioned functional recitations have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6<sup>th</sup> paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Appellant respectfully disagrees with the Examiner's assertion that a chamber being capable of accepting (as recited in claim 1) or adapted to accept (as recited in claim 13) a removable external device should not be afforded patentable weight.

In *Fuller*, the court concludes that a functional recitation that describes a result only, and not a process, is not patentable. However, the legal principle the Examiner is extrapolating from this 1929 decision is not consistent with

current patent law. There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Further, functional definitions are not only common but have been expressly approved in many cases including *Locklin et al. v. Switzer Bros., Inc.*, 299 F.2d 160, 131 USPQ 294 (C.A. 9th); *Sales Affiliates, Inc. v. Hutzler Bros. Co.*, 71 F.Supp. 287, 72 USPQ 211 (D.C. Md), at 216, *aff'd.*, 164 F.2d 260, 75 USPQ 259 ; *Ex parte Sperr*, 12 USPQ 194 (PO Bd.); *Ex parte Carter*, 52 USPQ 186 (PO Bd.); *Ex parte Kellog*, 84 USPQ 380 (PO Bd.); and *Ex parte Ebel and Drew*, 84 USPQ 202 (PO Bd.). Also, analogous "functional" limitations with respect to uncritical time or temperature have been approved in claims in: *Ex parte Ebel and Drew, supra*; *Ex parte Fowler and Otis*, 46 USPQ 425 (PO Bd.); *Procter & Gamble Mfg. Co. v. Refining, Inc.*, 135 F.2d 900, 57 USPQ 505 (C.A. 4th); and *Ex parte Clarke*, 98 USPQ 195 (PO Bd.).

Further, it is well established that functional elements should be considered in claim analysis. In *Clements Industries Inc. v. A. Meyers & Sons Corp.*, 12 USPQ2d 1874 (SD NY 1989), the Court stated "We are aware that functional language such as that here at issue ... is allowed in claims and is entitled to full weight in claim analysis" citing to *In re Swinehart and Sfiligoj*, 169 USPQ 226 (CCPA 1971).

For the above reasons, it is respectfully submitted that “a chamber being capable of accepting a removable external device” as recited in claim 1, should be afforded patentable weight.

The Examiner additionally asserts in the Official Action mailed December 11, 2003, on page 3, lines 15-17 as follows:

Also, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Again, Appellant respectfully disagrees with the Examiner’s assertions. It is respectfully submitted that the Court in *In re Hutchison* was considering the patentability of the following claim 42 at 140

42. As an article of manufacture, *adapted for use in the fabrication of a metal template or the like suitable for metal-working operations*, a laminated unit comprising a backing element surfaced with paper having an exposed outer surface to receive ...

In deciding the patentability of the functional “adapted” clause as italicized above, the Court stated at 141

Taking first claim 42 for analysis and comparing it principally with the Moxon patent, the first phraseology italicized by appellant is the introductory clause to the effect that the laminated article is “adapted” for use in making a template or the like. This does not constitute a limitation in any patentable sense, but if it were in that category, it is anticipated by Moxon who teaches that his laminated sheet (made up of layers of paper and metal, united by an adhesive) may be used in making a template.

As such, the court stated that the functional “adapted” clause did not constitute a limitation in any patentable sense since the clause appeared in the introduction, or the preamble, of the claim. As such, the Examiner’s statement that any recitation of an element that is “adapted to” or “capable of” performing



a function that is not a positive limitation does not have patentable weight is an erroneous characterization of the Court's decision. The Court did not hold that all functional "adapted to" clauses do not have patentable weight. The Court merely found that since the "adapted to" clause appears in the introduction, or the preamble, of the claim, it does not have patentable weight.

Additionally, it is respectfully submitted that the Examiner admits that the functional clause requires the prior art to have the ability to perform the function. Since claim 1 recites, *inter alia*, a personal computer comprising a chamber capable of accepting a removable external device, it is respectfully submitted that the camera hole 22 of *Ma* is not capable of accepting a removable external device. As such, by Examiner's own admission, the device disclosed in the *Ma* reference does not have the ability to perform the "function" as set out in claim 1, namely a chamber capable of interchangeably accepting an external device. As such, it is respectfully submitted that the clause "a chamber capable of interchangeably accepting an external device" should be afforded patentable weight. Further, it is respectfully submitted that *Ma* fails to anticipate the personal computer set forth in claim 1.

It appears that the Examiner is confused regarding when functional recitations render a claim patentable. As set forth in the *Clements* decision, the court held that "where the construction disclosed in the prior patent would inherently accomplish the general purpose of the patent-in-suit, then the later patent cannot stand." It is respectfully submitted that, in the present case, the device in the *Ma* reference cannot accomplish the general purpose of the

invention set forth in the present application, namely having the chamber accepting a removable external device.

Further, the Examiner's assertion that in order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function as set forth in 35 U.S.C. § 112, 6<sup>th</sup> paragraph, is clearly erroneous. Functional language may be included in many different types of claims, including method and apparatus claims and are still afforded patentable weight. See *Clements* and *Swinehart*. 35 U.S.C. § 112, 6<sup>th</sup> paragraph, states "[a]n element for a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." There is no requirement that that functional recitations be written in the means-plus-function form.

For all of the reasons set forth above, it is respectfully submitted that "a chamber capable of accepting a removable external device" should be afforded patentable weight. As *Ma* fails to teach or suggest this element, it is respectfully

4. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claims 2-7, 9, 11, and 24-25

Claims 2-7, 9, 11, and 24-25 depend directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(e) based on the teachings of *Ma* fails to establish *prima facie* anticipation of claims 2-7, 9, 11, and 24-25 for

at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claims 2-7, 9, 11, and 24-25 are separately patentable and offers the following additional argument for the invention of claims 2-7, 9, 11, and 24-25.

As discussed above with regard to claim 1, *Ma* fails to teach or suggest “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit,” as recited in claim 1. As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claims 2-7, 9, 11, and 24-25, in combination with the elements set forth independent claim 1, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. § 102(e). Thus, claims 2-7, 9, 11, and 24-25 are patentable over *Ma*.

5. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 13

Independent claim 13 is directed to a personal computer including, *inter alia*, a chamber disposed within the display unit, the chamber adapted to accept at least a portion of a removable external device therewithin.

The Examiner utilizes the assertions above to reject claim 13. However, as noted above, the claim element “the chamber adapted to accept at least a portion of a removable external device therewithin” should be afforded patentable weight.

Additionally, *Ma* fails to teach or suggest “the chamber adapted to accept at least a portion of a removable external device therewithin” for the reasons set forth above with regard to claim 1. It is respectfully submitted that *Ma* fails to anticipate the invention as set forth in claim 13. Based upon the Examiner’s failure to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102.

6. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 14

Independent claim 14 is directed to a method for providing an interface to a removable external device in a computer. The method includes, *inter alia*, providing an electrical connection inside the chamber such that at least a portion of the removable external device is capable of being inserted into the chamber such that an electrical connection is established therewithin between the removable external device and the electrical connector.

In support of the Examiner’s rejection of claim 14, the Examiner asserts in the Official Action mailed December 11, 2003, page 5, lines 19-20 as follows:

Regarding claim 14, the method steps recited in the claim are inherently necessitated by the device structure as *Ma* discloses it.

As noted above, *Ma* teaches establishing a permanent connection between the camera 222 and the sound boxes 212. Neither camera 222 nor sound boxes 212 are removable external devices. As *Ma* fails to teach a chamber accepting a removable external device, as noted above with regard to

claim 1, *Ma* does not inherently teach providing an electrical connection inside the chamber such that at least a portion of the removable external device is capable of being inserted into the chamber such that an electrical connection is established therewithin between the removable external device and the electrical connector. As such, it is respectfully submitted that claim 14 is not anticipated by *Ma*. As such, the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. §102.

7. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 15

Independent claim 15 is directed to an apparatus for interfacing a computer with a removable external device. The apparatus includes, *inter alia*, a chamber having a predetermined depth, the chamber disposed in the display unit, the chamber having an electrical connection in an innermost recess thereof, the chamber configured to accept at least a portion of the removable external device such that an electrical connection can be established between the computer and the removable external device.

In support of his rejection, the Examiner utilizes the same reasoning as noted above with regard to independent claims 1 and 13. However, as noted above, the claim element “the chamber configured to accept at least a portion of the removable external device” should be afforded patentable weight.

Additionally, *Ma* fails to teach or suggest “the chamber adapted to accept at least a portion of a removable external device therewithin” for the reasons

set forth above with regard to claim 1. It is respectfully submitted that *Ma* fails to anticipate the invention as set forth in claim 15 as *Ma* fails to teach or suggest a chamber having a predetermined depth, the chamber disposed in the display unit, the chamber having an electrical connection in an innermost recess thereof, the chamber configured to accept at least a portion of the removable external device such that an electrical connection can be established between the computer and the removable external device. Based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102.

8. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 16

Independent claim 16 is directed to an apparatus for interfacing a computer with a removable external device. The apparatus includes, *inter alia*, a chamber formed inside the display unit, the chamber having an opening disposed on the outside of the display unit configured to adaptable receive the removable external device.

Again, in support of his rejection, the Examiner utilizes the same reasoning as noted above with regard to independent claims 1 and 13. However, as noted above, the claim element "formed inside the display unit, the chamber having an opening disposed on the outside of the display unit

configured to adaptable receive the removable external device” should be afforded patentable weight.

Additionally, *Ma* fails to teach or suggest “a chamber formed inside the display unit, the chamber having an opening disposed on the outside of the display unit configured to adaptable receive the removable external device” for the reasons set forth above with regard to claim 1. It is respectfully submitted that *Ma* fails to anticipate the invention as set forth in claim 16 as *Ma* fails to teach or suggest a chamber formed inside the display unit, the chamber having an opening disposed on the outside of the display unit configured to adaptable receive the removable external device. Based upon the Examiner’s failure to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102.

B. Issue (2): The *Brenner* Rejection

1. Argument Summary

The Examiner’s rejection of claims 17, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by *Brenner* fails to establish *prima facie* anticipation. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the *Brenner* reference that a detailed reading of the reference reveals are not taught therein.

2. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 17

Independent claim 17 is directed to a method for providing an interface to a removable external device in a computer. The method includes, *inter alia*, forming a chamber inside a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit, and the chamber having walls for covering a bottom side, a right and left side, and a front and back side of the removable external device, wherein the chamber is configured to receive the removable external device.

In support of the Examiner's rejection of claim 17, the Examiner, in the Official Action mailed December 11, 2003, page 6, lines 3 through 11 asserts as follows:

Regarding claim 17, Brenner disclosed a computer structure (Fig. 1 and 7) which inherently necessitates the method steps recited in the claims, including forming a chamber (146) inside a display unit (102) coupled to the computer, the display unit (102) having a display face (122) and being movably coupled to a base unit (114) such that the display face (122) formed an angle generally less than 180° with the base unit (114), and the chamber having walls (inherently) for covering a bottom side, a right and left side, and a front and back side of the removable external device (116), wherein the chamber (146) is configured to receive the removable external device (116); and forming an opening associated with the chamber such that only the opening of the chamber is disposed on the outside of the display unit (102).

Appellant respectfully disagrees with the Examiner's characterization of this reference.

It is respectfully submitted that the disclosure set forth in *Brenner* is directed to an information device with a display and keyboard having



corresponding sets of function keys. *Brenner* discloses computer 100 including a display screen 122 disposed on a front surface 102 of a display screen portion 132. The display screen portion 132 projects rearwardly from a base 114 at a predetermined angle so that a display screen is visible to and optimally positioned for a seated or a standing user (col. 4, lines 31-41).

The Examiner relies on *Brenner's* teaching of a display face 122 and a base unit 114. However, it is respectfully submitted that *Brenner* fails to disclose a display unit having a display face being movably coupled to a base unit such that the **display face** forms an angle generally less than 180° with the base unit as recited in claim 17. As shown in Fig. 1, the display face forms an angle greater than 180° with the base unit. As the Examiner has failed to provide a reference that teaches all of the claim elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. §102.

3. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 29

Claim 29 depends directly from claim 17. Appellant submits that the rejection under 35 U.S.C. § 102(e) based on the teachings of *Brenner* fails to establish *prima facie* anticipation of claim 29 for at least the reasons set forth above concerning claim 17. Appellant also submits that dependent claim 29 is separately patentable and offers the following additional argument for the invention of claim 29.

As discussed above with regard to claim 17, *Brenner* fails to teach or suggest “a display unit having a display face being movably coupled to a base unit such that the **display face** forms an angle generally less than 180° with the base unit,” as recited in claim 17. As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claim 29, in combination with the elements set forth independent claim 17, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. § 102(e). Thus, claim 29 is patentable over *Brenner*.

4. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 30

Claim 30 depends directly from claim 17. Appellant submits that the rejection under 35 U.S.C. § 102(e) based on the teachings of *Brenner* fails to establish *prima facie* anticipation of claim 30 for at least the reasons set forth above concerning claim 17. Appellant also submits that dependent claim 30 is separately patentable and offers the following additional argument for the invention of claim 30.

As discussed above with regard to claim 17, *Brenner* fails to teach or suggest “a display unit having a display face being movably coupled to a base unit such that the **display face** forms an angle generally less than 180° with the base unit,” as recited in claim 17. As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claim 30, in combination with the elements set forth independent claim 17, it is respectfully

submitted that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. § 102(e). Thus, claim 30 is patentable over *Brenner*.

Further, while the Examiner asserts that certain functional language should not be afforded patentable weight, Appellant maintains his position that the phrase “the display unit is capable of closing the display face when the personal computer is not in use” should be afforded patentable weight based upon the reasons set forth above.

Further, *Brenner* fails to teach or suggest “the display unit is capable of closing the display face when the personal computer is not in use.” The information device disclosed in *Brenner* does not provide for closing the display face with the personal computer is not in use. For all of these reasons, it is respectfully submitted that claim 30 is not anticipated by *Brenner*.

C. Issue (3): The *Griencewic* Rejection

1. Argument Summary

The Examiner’s rejection of claim 31 under 35 U.S.C. § 102(e) as being anticipated by *Griencewic* fails to establish *prima facie* anticipation. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the *Griencewic* reference that a detailed reading of the reference reveals are not taught therein.

2. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 31

Independent claim 31 is directed to a device for interacting with a personal computing apparatus. The device includes, *inter alia*, a portion for removably electrically connecting to a personal computer.

In support of the Examiner's rejection of claim 31, the Examiner, in the Official Action mailed December 11, 2003, page 7, paragraph 5 asserts as follows:

Griencewic disclosed (Fig. 10, 11) a device (128) for interacting with a personal computing apparatus, the device comprising: a portion (142) for removably and electrically connecting to a personal computer; and a camber (120) positions opposite of the portion for removably electrically connecting to the personal computer on the device (128), wherein when the device is interacting with the personal computer, a view from the lens of the camera is substantially perpendicular to a direction of insertion of the device into the personal computer (Fig. 11).

Appellant respectfully disagrees with the Examiner's characterization of this reference.

It is respectfully submitted that the disclosure set forth in *Griencewic* is directed to an adjustably mounted camera assembly for portable computers. The camera assembly is moveable relative to the portable computer so that the viewing direction may be adjusted without moving the main body section or display screen (Abstract). *Griencewic* further teaches in col. 6, line 60 through col. 7, line 6 as follows:

As camera assembly 120 is retracted to a storage position within channel 130 (FIG. 10), shuttle block 142 moves to the lower end 146 of shuttle tube 140 where spring tension members 144 will engage detents 150 to positively hold camera assembly 120 in place. As camera assembly 120 is extended to an operational position extending from channel 130 (FIGS. 9 and 11), shuttle block 142 moves to the upper end 148 of shuttle tube

140 wherein the spring tension members 145 engage detents 150 in the shuttle block. Additionally, a third pair of spring tension members (not shown) may be disposed within camera nest 134 for engaging detents 156 formed in camera housing 122 as illustrated in FIG. 11 providing positive positioning for camera housing 122 as well.

However, there is no teaching in *Griencewic* that is directed to a portion for removably electrically connecting to a personal computer. *Griencewic* merely provides for retraction of the camera within the computer opening 133. As the Examiner has failed to provide a reference that teaches all of the elements as recited in claim 31, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. §102.

D. Issue (4): The *Ma/Smith* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Ma* in view of *Smith* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the primary reference, *Ma*, that a detailed reading of the reference reveals are not taught therein and these deficiencies are not cured by the teachings of *Smith*.

2. The Legal Requirements of *Prima Facie* Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion,

or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

3. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 12 and 28

Claims 12 and 28 depend either directly or indirectly from claim 1. As claims 12 and 28 are dependent from allowable claim 1, it is respectfully submitted that claims 12 and 28 are allowable for at least the reasons set forth above with regard to claim 1. Appellant also submits that dependent claims 12 and 28 are separately patentable and offers the following additional argument for the invention of claims 12 and 28.

As discussed above with regard to claim 1, *Ma* fails to teach or suggest “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit,” as recited in claim 1. *Smith* fails to cure the deficiencies of the teachings

of *Ma* as *Smith* fails to teach or suggest “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit,” assuming these references are combinable, which Appellant does not admit. As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claims 12 and 28, in combination with the elements set forth independent claim 1, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Thus, claims 12 and 28 are patentable over *Ma* in view of *Smith*.

E. Issue (5): The *Ma/Brenner* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claims 10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Ma* in view of *Brenner* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the primary reference, *Ma*, that a detailed reading of the reference reveals are not taught therein and these deficiencies are not cured by the teachings of *Brenner*.

2. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 10 and 26

Claims 10 and 26 depend either directly or indirectly from claim 1. As claims 10 and 26 are dependent from allowable claim 1, it is respectfully

submitted that claims 10 and 26 are allowable for at least the reasons set forth above with regard to claim 1. Appellant further submits that the rejection under 35 U.S.C. § 103(a) based on the teachings of *Ma* in view of *Brenner* fails to establish *prima facie* obviousness of claims 10 and 26. Appellant also submits that dependent claims 10 and 26 are separately patentable and offers the following additional argument for the invention of claims 10 and 26.

As discussed above with regard to claim 1, *Ma* fails to teach or suggest “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit,” as recited in claim 1. *Brenner* fails to cure the deficiencies of the teachings of *Ma* as *Brenner* fails to teach or suggest “a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit,” assuming these references are combinable, which Appellant does not admit. As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claims 10 and 26, in combination with the elements set forth independent claim 1, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Thus, claims 10 and 26 are patentable over *Ma* in view of *Brenner*.





X. CONCLUSION

For the reasons specifically set forth above, the outstanding rejections set forth in the Final Office Action should be reversed.

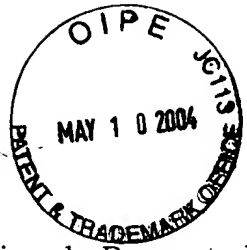
Respectfully submitted,

BIRCH STEWART KOLASCH & BIRCH LLP

By  #39,491  
for Michael K. Mutter, Reg. No. 29,680

  
MKM/CMV/lab/jdm  
0879-0242P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000



**Appendix of Claims**

1. (Previously Presented) A personal computer, comprising:
  - a base unit;
  - an input part arranged on the base unit, the input part having an operation face;
  - a display unit having a display face, the display unit being operatively interconnected to the base unit in a state that the display face forms an angle less than  $180^\circ$  with the operation face when the personal computer is in use; and
  - a chamber capable of accepting a removable external device enhancing a function of the personal computer, the chamber being arranged in the display unit.
2. (Original) The personal computer as defined in claim 1, wherein the display unit is capable of closing the display face when the personal computer is not in use.
3. (Original) The personal computer as defined in claim 1, wherein the display unit is capable of closing the operation face when the personal computer is not in use.
4. (Original) The personal computer as defined in claim 1, wherein the display unit is hinged to the base unit.

5. (Original) The personal computer as defined in claim 1, wherein the display unit is rigidly joined to the base unit in the state that the display face forms the angle less than  $180^{\circ}$  with the operation face.
6. (Original) The personal computer as defined in claim 1, wherein the chamber opens at a top side of the display unit.
7. (Original) The personal computer as defined in claim 1, wherein the chamber opens at a lateral side of the display unit.
8. (Original) The personal computer as defined in claim 1, wherein the display unit comprises at least one of a cutout part and a transparent part so that whether the external device is inserted in the chamber can be determined by seeing through the at least one of the cutout part and the transparent part.
9. (Original) The personal computer as defined in claim 1, wherein the input part comprises at least one of a keyboard, a trackpad and a trackball.
10. (Previously Presented) The personal computer as defined in claim 1, wherein the external device is a memory card.
11. (Original) The personal computer as defined in claim 1, wherein the external device comprises a camera.

12. (Original) The personal computer as defined in claim 1, wherein the external device comprises a wireless communication device.

13. (Previously Presented) A personal computer comprising:

a display unit having a display face, the display unit movably coupled to a base unit such that an angle between the display face and the base unit is generally less than  $180^\circ$ ; and

a chamber disposed within the display unit, the chamber adapted to accept at least a portion of a removable external device therewithin.

14. (Previously Presented) A method for providing an interface to a removable external device in a computer comprising:

forming a chamber in a display unit of the computer, the display unit having a display face, the display unit being movably coupled to a base unit such that the display face forms an angle generally less than  $180^\circ$  with the base unit such that an opening associated with the chamber is exposed to the outside of the display unit; and

providing an electrical connection inside the chamber such that at least a portion of the removable external device is capable of being inserted into the chamber such that an electrical connection is established therewithin between the removable external device and the electrical connector.

15. (Previously Presented) An apparatus for interfacing a computer with a removable external device, the apparatus comprising:

a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than  $180^\circ$  with the base unit; and

a chamber having a predetermined depth, the chamber disposed in the display unit, the chamber having an electrical connection in an innermost recess thereof, the chamber configured to accept at least a portion of the removable external device such that an electrical connection can be established between the computer and the removable external device.

16. (Previously Presented) An apparatus for interfacing a computer with a removable external device, the apparatus comprising:

a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than  $180^\circ$  with the base unit; and

a chamber formed inside the display unit, the chamber having walls capable of covering the bottom side, a left and right side, and a front and back side of the removable external device, the chamber having an opening disposed on the outside of the display unit configured to adaptably receive the removable external device.

17. (Previously Presented) A method for providing an interface to a removable external device in a computer comprising:

forming a chamber inside a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than  $180^\circ$  with the base unit, and the chamber having walls for covering a bottom side, a right and left side, and a front and back side of the removable external device, wherein the chamber is configured to receive the removable external device; and

forming an opening associated with the chamber such that only the opening of the chamber is disposed on the outside of the display unit.

18.-23. (Cancelled).

24. (New) The personal computer of claim 1, wherein the removable device may be removed without the disassembly of the personal computer.

25. (New) The personal computer of claim 1, wherein the chamber is capable of interchangeably accepting the removable device.

26. (New) The personal computer of claim 10, wherein the memory card interacts with the personal computer when inserted in the slot.

27. (New) The personal computer of claim 11, wherein the camera interacts with the personal computer when inserted in the slot.

28. (New) The personal computer of claim 12, wherein the wireless communication device interacts with the personal computer when inserted in the slot.

29. (New) The method of claim 17, further including:

providing for an input part arranged on the base unit, the input part having an operation face.

30. (New) The method of claim 17, wherein the display unit is capable of closing the display face when the personal computer is not in use.

31. (New) A device for interacting with a personal computing apparatus, the device comprising:

a portion for removably electrically connecting to a personal computer;  
and

a camera positioned opposite of the portion for removably electrically connecting to the personal computer on the device,  
wherein when the device is interacting with the personal computer, a view from the lens of the camera is substantially perpendicular to a direction of insertion of the device into the personal computer.